

RESPONSE TO RESTRICTION REQUIREMENT

Serial No. 10/727,774

Page 7 of 8

REMARKS

In response to the Office Action dated January 12, 2006, which imposed a restriction requirement in the above-captioned patent application, the Applicant provisionally elects to prosecute claims 1-11 of Group I. The Applicant additionally has amended claims 12-16 to depend on independent claim 1. Thus, claim 1 is now generic to claims 12-16.

The Applicant respectfully submits that the restriction does not conform with MPEP §803 which outlines the criteria for making a proper restriction. Specifically, a restriction is proper when an application contains inventions that are independent or distinct as claimed, and that there must be a serious burden on the Examiner if restriction is required. The Examiner is required to provide reasons and/or examples to support his conclusion. The Examiner may provide a prima facie evidence of a serious burden by showing an appropriate explanation either of separate classification, separate status in the art, or a different field of search.

The Applicant respectfully submits that the Examiner has not demonstrated a serious burden in requiring a restriction in the present application. The Examiner has stated the restriction is proper because the different inventions have different modes of operation. The Applicant submits that Examiner's search for pad assemblies having a subpad recited in claims to the non-elected species of Group II presents minimal, if any, additional burden on the Examiner. Moreover, the species of Groups I and II have similar, if not identical modes of operation. Both groups are used for planarizing a workpiece. Since the species of Group I and II of the present application present a reasonable number of species and no serious burden is placed on the Examiner, consideration of the claimed embodiments of Groups I and II is proper under 37 C.F.R. §1.141 and §1.146.

The species of Group II depend from generic claim 1 of Group I. Thus, the Applicant respectfully requests claims 1-16 be considered by the Examiner. Claims 17-25 are withdrawn without prejudice. The Applicant reserves the right to file divisional/continuation applications to prosecute the non-elected subject matter.

RESPONSE TO RESTRICTION REQUIREMENT

Serial No. 10/727,774

Page 8 of 8

The Applicant submits that all claims now pending are in condition for allowance. Accordingly, both consideration of this application and its swift passage to issue are earnestly solicited. If the Examiner believes that any unresolved issues still exist, it is requested that the Examiner telephone Keith Taboada at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Jan 30, 2006

Keith P. TABOADA
Attorney Reg. No. 45,150
(732) 530-9404

Patterson & Sheridan, LLP
Attorneys at Law
595 Shrewsbury Avenue
Suite 100
Shrewsbury, NJ 07702